

Remarks

Claims 30, 33-35, 37-39, and 43 are pending in the subject application. By this Amendment, Applicants have canceled claims 40-42 and 126-129, and amended claims 30 and 37-39. Support for the new claims can be found throughout the subject specification and in the claims as originally filed (see, for example, specification, page 13, lines 20-30 and pages 37-38). Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 30, 33-35, 37-39, and 43 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested. Applicants respectfully submit that this amendment will not necessitate a new search or raise new issues for consideration by the Examiner. Applicants also wish to thank Examiner Baker for the courtesy of the interview of August 14, 2003 during which the rejections of record were discussed.

Claims 30 and 129 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office Action argues that the application fails to provide an adequate written description of the claimed invention in that the specification fails to support steps for determining whether any array (or any sample type) has therein "at least one sample has decrease solubility and at least one sample has synergistic increased solubility". Applicants respectfully traverse.

It is respectfully submitted that the specification, as filed, provides adequate written support for the claimed invention (see Example 3, page 42). Here it is disclosed that at least one sample of griseovulvin exhibited decreased solubility and at least one sample containing griseovulvin exhibited synergistic increased solubility in the tested excipients. Thus, it is respectfully submitted that the specification does provide adequate written support for the claimed invention and, accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claims 33, 35-38, 40-42, and 126-128 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

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Claims 40-42 were rejected on the basis that the claims recited a number of samples that was less than that recited in the independent claim from which the claims depended. It is respectfully submitted that this issue is moot in view of the cancellation of the claims. Claims 33, 35, and 127 were rejected on the basis that the claims recited the term "properly", a term no longer present in the claim from which each claim depended. It is respectfully submitted that this term was not present in claims 33 and 35 and withdrawal of this aspect of the rejection is respectfully requested. With respect to the rejection as applied to claim 127, it is respectfully submitted that the cancellation of this claim has made this issue moot. Claims 36-38, 126, and 128 were rejected on the grounds that the claims recited the phrase "active component" and that this phrase was not found in the independent claim from which claims 36-38, 126, and 128 depended. Applicants have amended the claims to recite the phrase found in the independent claim ("active pharmaceutical ingredient") and respectfully submit that this issue has been resolved via the amendments made to the claims in this response. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claims 30, 33-35, 37-43, 126 and 127 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mak *et al.* (U.S. Patent No. 5,490,415; of record) in view of Liu *et al.* (U.S. Patent No. 6,271,038) and Stylli *et al.* (U.S. Patent No. 5,985,214; of record) and claims 30, 33-35, 37-43, 126 and 127 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takai *et al.* (Chem. Pharm. Bulletin, 1984; of record) in view of Liu *et al.* (U.S. Patent No. 6,271,038) and Stylli *et al.* (U.S. Patent No. 5,985,214; of record). Applicants respectfully traverse.

It is respectfully submitted that the rejections of record fails to render the claimed invention obvious. As the Patent Office is aware, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, to establish *prima facie* obviousness for a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is respectfully submitted that the rejections of record fail to meet this burden. For example, each of the combination of references fails to teach an array of griseovulvin and wherein at least one sample has

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decreased solubility and at least one sample has a synergistic increased solubility. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

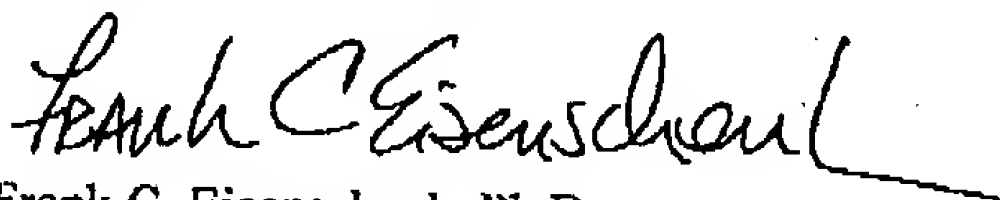
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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